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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,804	02/09/2004	Nicholas William Geary	CM2310M2C2	9053

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CINCINNATI, OH 45224

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/774,804

**Applicant(s)**

GEARY ET AL.

**Examiner**

JYOTHSNA A VENKAT

**Art Unit**

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/264,500.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of IDS filed on 2/9/04. Claims 1-20 are pending in the application and the status of the application is as follows:

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1, 5, 14 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

1. The expression “*as defined herein*” is indefinite, as the claim does not define the test method. Deletion of the expression would overcome the rejection for claims 1 and 19.
2. Claim 5 is in the improper Markush group format. Deletion of the first occurrence of “*and*” at line 3 before “**fatty alcohols**” would overcome this rejection.
3. Claim 14 lacks antecedent basis with respect the combing index value 1.1. Note that claim 1 recites that the “*average combing index value is greater than 1.2*”. Additionally the claim recites “*combing index value*” and “*combing value*”. Both the expressions lack antecedent basis.
3. Claim 20 is unclear as to applicant’s intent with respect to (a). Explanation is requested with respect to “initial coloring composition and hair altering composition”. Is there any difference between both these compositions?

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3. Claim 16 provides for the use of coloring and conditioning, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, and 7-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U. S. Patent 5,376,146 ('146).

The instant application is claiming a hair coloring and conditioning composition and method of a hair coloring and conditioning, a kit and a packaged hair coloring and conditioning product comprising:

*1. At least one conditioning agent*

*2. At least one hair coloring agent*

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*3. Oxidizing agent (claims 9-11)*

See column 11, under examples 1-40. Behentrimonium chloride or Cetrimonium chloride or Stearalkonium chloride reads on the claimed conditioning agent, which is also the claimed cationic conditioning polymer. P-Phenylenediamine reads on the claimed ingredient 2 and hydrogen peroxide reads on the claimed ingredient 3. Since the components are same the Ph and the average combing index value claimed in claims 1-3, 12, and 19 is inherent absence of evidence to the contrary. See claim 5 which reads on claim 18 see also column 11, lines 8-18 for the kit and since these components are in two different containers the package claimed in claim 19 is inherent.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of patent '146 and WO 95/20939 ('939).

The instant application is claiming a hair coloring and conditioning composition and method of a hair coloring and conditioning, a kit and a packaged hair coloring and conditioning product comprising:

1. *At least one conditioning agent (combination of cationic conditioning polymer, silicone conditioning agent, and fatty alcohol)*
2. *At least one hair coloring agent*
3. *Oxidizing agent (claims 9-11)*

The patent '146 discloses all the ingredients claimed except for claim 6 limitation. However the WO document teaches claim 6 components in the hair rinse compositions at pages 20-21 under examples I-V and the document at page 19 lines 27-36 teaches optional ingredients, which are the hair-coloring agents and hydrogen peroxide.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '146 and pack in a KIT and combine it with the *conditioning agents which are combination of cationic conditioning polymer, silicone conditioning agent, and fatty alcohol*, expecting beneficial effect to the hair. The motivation to use the silicone stems from the teachings of WO that silicones enhance the glossiness of the hair, and the other two components when present in the compositions dry combing, volume reduction to the hair. This is a prima facie case of obvious ness.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-

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0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JYOTHSNA VENKAT**  
Primary Examiner  
Art Unit 1615

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